

REMARKS

Support for Amendments

The limitation of claim 2 has been incorporated into claim 1. In addition, the range for the amount of "one of more ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymers" has been narrowed from the originally filed claims. Support for this limitation can be found in Examples 1-7 of the specification.

Claims 1 and 3-8 are now pending. It is believed that no new matter has been added.

Justification for Entry of Amendment After Final

At the outset, Applicants wish to address the showing required under 37 CFR § 1.116(a) regarding why the amendments above are necessary and were not presented earlier. According to MPEP 714.13 (Amendments After Final Rejection or Action, Procedure Followed - Action by Examiner), there are four grounds (cited as (A)-(D)) upon which the examiner may elect not to enter the applicants amendment. Each ground is addressed below:

(A) The claims as amended represent a narrower embodiment of the applicants originally claimed invention (applicants reserve the right to pursue broader scope of the original claims in continuing application) and as such it is believed that the amended claims are now in condition for allowance or at the very least simplifies the issues for appeal.

(B) It is believed that no new matter has been entered.

(C) The amended claims represent a narrower embodiment of the applicants invention as claimed prior to the issuance of the examiner's final rejection and as such no new issues are raised which require further consideration or search.

(D) The amendment does not present any additional claims.

In view of the foregoing, Applicants respectfully request that the Examiner enter and consider the amendments above.

Response to 35 U.S.C. 103(a) rejections

Claims 1-3 and 6 as presented in the previous response were rejected by the examiner over Beerse et al. (U.S. Patent 6,294,186)

While the applicants stand by the arguments presented in the previous response, since the examiner recited *In re McLaughlin* in her response (which is also addressed in the rejection of claims 4, 5, 7 and 8), the examiner's attention is also directed to the very next paragraph in the MPEP after the recitation of *In re Laughlin*. i.e. MPEP 2145 X. (Arguing Improper Rationales for Combining References) B. (Obvious to Try Rationale) - see page 2100-156 (Rev. 1, Feb. 2003):

"An applicant may argue the examiner is applying an improper "obvious to try" rationale in support of an obviousness rejection.

"The admonition that 'obvious to try' is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.)."

The Beerse reference does not have the "detailed enabling methodology", "suggestion to modify" or "evidence suggesting modification would be successful" which was present in the *O'Farrell* decision.

With the amendments to the claims made above, the Beerse reference is even further away from suggesting the obviousness of the applicants' claimed invention.

Claims 4, 5, 7 and 8 as presented in the previous response were rejected by the examiner over Beerse et al. in view of Applicants' admission regarding the prior art.

The examiner recited *In re McLaughlin* in support of the obviousness rejection for claim 1-3 and 6 above (i.e. "...But so long as it takes account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and **does not include knowledge gleaned only from the applicant's disclosure**, such a reconstruction is proper.").

The passages referred to by the examiner which are allegedly "Applicant's admissions" only apply within the context of the invention (i.e. paragraph [0130] - "The emulsions **according to the invention** can comprise dyes and/or color pigments..."). This is not the same as a generic commentary as to the addition of a dye and/or color pigment to any composition.

The only teaching or suggestion to make the necessary combination is therefore gleaned from the applicant's disclosure.

The examiner also wrote that "As discussed in the previous Office Action, adding dyes coloring pigments to a cosmetic composition is considered well within conventional skills in cosmetic science or industry...". However, the examiner's rejection was supported by the "applicant's admission" not a taking of an official notice (see MPEP 2144.03). If the examiner wishes to change her rejection to a holding of official notice, this response should be considered an official traversal of taking official notice.

Even if a reference is provided to supplement this rejection, the applicants present that the examiner's other basis for maintaining this rejection are contradicted by the MPEP:

- (1) "adding dyes coloring pigments to a cosmetic composition is considered well within conventional skills in cosmetic science or industry"

MPEP 2143.01 further states that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed

invention was made' because the references relied upon teach that all aspects of the claimed invention were known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993)."

If the examiner's basis for the objective reason is that the references could be combined, MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990).

- (2) "It has been held that it is within the skill in the art to select optimal parameters, ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980)."

The *Boesch* decision is also recited in MPEP 2144.05 II. (Optimization of Ranges) B. (Only Results Effective Variables Can Be Optimized) and has been misrepresented by the above statement. The first part of this section reads as: "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)."

The *Beerse et al.* reference makes no such disclosure of dyes/coloring pigments being a results-effective variable.

Closing

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (7 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **22 May 2003**

By: 

Vilma I. Fernandez